



20 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

#6

Ilya Zborovsky  
Ely Zborovsky Patent Bureau  
6 Schoolhouse Way  
Dix Hills, NY 11748

In re Application of	:	
SEREDA, et al.	:	
Application No.: 09/719,487	:	DECISION ON PETITION
PCT No.: PCT/IB98/01431	:	
Int. Filing Date: 08 July 1998	:	UNDER 37 CFR 1.181
Priority Date: 11 June 1998	:	
For: HETEROGENEOUS LIQUID-PHASE	:	
CRYSTALLISATION OF DIAMOND	:	

This decision is in response to applicant's papers filed 10 May 2002 in the United States Patent and Trademark Office (USPTO). The papers are being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

### **BACKGROUND**

On 08 July 1998, applicant filed international application PCT/IB98/01431, which claimed priority of an earlier application filed 11 June 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 16 December 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 2000.

On 11 December 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application into English and signed declaration of the inventors.

On 14 June 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905); a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) and a NOTIFICATION OF DEFECTIVE TRANSLATION (Form PCT/DO/EO/913) informing applicant of the need to provide a signed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. In addition, applicant was advised of the need to provide payment of the applicable surcharge and processing fee for providing an oath or declaration, and compliant English translation of the international application, later than thirty months from the priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and

payment of fees.

On 14 August 2001, the application became abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905); NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) and NOTIFICATION OF DEFECTIVE TRANSLATION (Form PCT/DO/EO/913) mailed 14 June 2001 within the time period set therein.

On 10 May 2002, applicant filed copies of papers purportedly filed on 14 September 2001. As discussed above, the submission is being treated as a petition under 37 CFR 1.181. No petition fee is required.

On 07 June 2002, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905); NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) and NOTIFICATION OF DEFECTIVE TRANSLATION (Form PCT/DO/EO/913) mailed 14 June 2001 within the time period set therein and that above-identified application was abandoned as to the United States.

### **DISCUSSION**

37 CFR 1.8(b) states:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice the correspondence will be considered timely filed if the party who forwarded the correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report

confirming transmission may be used to support this statement.

With the present petition, applicant has satisfied items (1) and (2) above.

Regarding item (3), applicant has not provided a statement attesting on a personal knowledge basis to the previous timely mailing. As such, applicant's petition under 37 CFR 1.181 can not be granted at this time.

It is noted that the declaration filed on 10 May 2002 does not comply with 37 CFR 1.497 (a)-(b). Specifically, the second listed inventor appears to be listed and executed as "Arkodly DYADENRO" whereas the International Application lists the second inventor as "Arkadi DYADENKO." Applicant must provide either a declaration executed with the name which appears on the international application, "Arkadi DYADENKO" or in the alternative, a petition under 37 CFR 1.182 requesting that applicant's name be changed to "Arkodly DYADENRO." In order to be granted, the petition under 37 CFR 1.182 must include an affidavit signed by inventor DYADENKO with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order as well as the \$130.00 petition fee. See Manual of Patent Examining Procedure (MPEP) 605.04(c). In addition, Section 201.03 of the MPEP provides the procedures where a typographical or transliteration error in the spelling of an inventor's name is discovered. As discussed in that section, in such an instance a petition under 37 CFR 1.48(a) is not required.

In addition, it is unclear as to which individuals are applicants and/or inventors in the United States National Stage for the present application. The published international application lists four inventors whereas the filed declaration identifies only SEREDA and "DYADENRO." A form PCT/IB/306 received from the International Bureau lists Mr. DYADENKO as an applicant who, "is not inventor, and should be considered as applicant for all designated States except the United States of America." As such, applicant is required to provide statements from the four individuals identified in the published international application detailing their status as to the United States of America.

### CONCLUSION

Applicant's petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.181." No additional fee is required.

Any renewed petition filed must include a proper reply. A proper reply must include a statement attesting on a personal knowledge basis to the previous timely mailing.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Richard Cole  
Legal Examiner  
PCT Legal Office



Derek A. Putonen  
Petitions Attorney  
PCT Legal Office  
Tel: (703) 305-0130  
Fax: (703) 308-6459